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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,601	04/06/2001	Steven L. Eikenberg	USAM117030	5690

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EXAMINER

BUMGARNER, MELBA N

ART UNIT PAPER NUMBER

3732

DATE MAILED: 02/23/2005

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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/828,601
Filing Date: April 06, 2001
Appellant(s): EIKENBERG, STEVEN L.

Office of the Staff Judge Advocate
US Army Medical Research and Materiel Command
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 3, 2004.

Art Unit: 3732

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct, though not fully. See section (11) for examiner's interpretation.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims do stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3732

(9) Prior Art of Record

FR2233032	SEIDMAN	1-1975
5,013,240	BAILEY et al	5-1991
4,445,859	HOFFMEISTER et al	5-1984
4,114,274	JONES	9-1978
4,571,182	BEIER et al	2-1986

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

These rejections were set forth in a prior Office Action, mailed on March 3, 2004.

1. Claims 1-4, 6, 7, 10, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman in view of Bailey et al. Seidman discloses a portable dental treatment system comprising at least one dental bracket table 1, at least one portable base unit 6 including the mechanisms needed to start up dental instruments inside, and at least one suspension device 7,8 couplable between the at least one dental bracket table and the at least one portable base unit; however, Seidman does not show the mechanism being at least one suction pump and a waste container. Bailey et al. teach a portable dental treatment system comprising a portable base unit including a suction pump 70 and waste container 71. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Seidman to include the suction pump and waste container. One would be motivated to make such a modification to provide suction to conventional dental suction instruments for removing waste during dental treatment and to provide a receptacle for the waste. As to claim 2, Seidman shows the at least one table comprising a dental hand piece holder. As to claim 3, Bailey et al. teach the base unit comprising an air compressor 33. It would have been obvious to modify the system of Seidman to include air compressor in order to directly provide compressed air to various hand pieces or to pressurize a reservoir of fluid used in dental treatment as taught by Bailey et al. As to claim 4, Seidman and Bailey et al. show the at least one unit comprises an enclosure. As to claim 6, the at least one device comprises a first member 7 operably coupled with a side of the at least one unit and a second member 8 at least partially transverse to the first member, the second member having a first end 11 operably coupled with the at least one table and a second end 13 operably coupled with the first member. As to claim 7, the first member is rotatably attached to the side. As to claim 10, the second member is rotatably attached to the at least one table. As to claims 18-21, Seidman show the method of assembling a portable dental treatment system of above, the device structured to allow a dental patient chair to be positioned substantially below the table.

Art Unit: 3732

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman in view of Bailey et al. and further in view of Hoffmeister et al. The modified system of Seidman and Bailey et al. shows the limitations as described above; however, they do not show the suspension device comprising a curved member. Hoffmeister et al. teach a dental treatment system comprising at least one device having a curved member 54. It is held to be an obvious matter of choice to one of ordinary skill in the art as to the shape of the member as in Hoffmeister et al. to serve as a suspension device for the table. The specific shape of the member is not critical to the claimed invention, since the applicant contemplates other configurations.

3. Claim 8 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Seidman in view of Bailey et al. and further in view of Jones. The modified system of Seidman and Bailey et al. shows the limitations as described above; however, they do not show a mounting bracket. Jones teaches a dental system comprising a mounting bracket affixed to the side of the unit and having a circular opening (figure 2) and the first member insertable in the opening. It would have been obvious to one having ordinary skill in the art to further modify the system to have the mounting bracket of Jones to have the suspension device secured to the unit.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman in view of Bailey et al. and further in view of Beier et al. The modified system of Seidman and Bailey et al. shows the limitations as described above; however, they do not show the second member integrally molded with the first member. Beier et al. teach a dental treatment system comprising the suspension device (first and second members) integrally molded 8. It would have been obvious to one having ordinary skill in the art to further modify the system to have the members of Beier et al. to form a device in one piece for ease of manufacturing and assembly.

(11) Response to Argument

Appellant's arguments of Issue 1 on page 3 to top of page 8 of the brief pertaining to the rejection under 35 U.S.C. 112 first paragraph are deemed to be persuasive. This rejection accordingly, has been withdrawn.

The following is the Examiner's response to arguments of Issue 2:

Firstly, the Appellant believes the Examiner erred in relying on a dictionary definition of "portable" in applying Seidman reference disclosing a portable dental treatment system as addressed on pages 8-10 of the brief. Appellant's argument on page 8, last paragraph, of the brief:

"In response, the Examiner, relying on the dictionary definition of "portable," noted that "[t]he prior art dental treatment system is portable in that it is shown to be 'capable of being carried or moved about.'" Applicant respectfully submits that the inventor as his own lexicographer has set forth a definition in the specification that clearly excludes those systems that are merely "movable" from those that are "portable.""

The only mention by the Appellant of a "portable dental treatment system" in terms of "dental treatment systems which have been designed such that they can be compacted and bundled so that a relatively fit person (e.g., a man or a woman) can physically carry the portable dental system" is found in the **Background of the Invention** (page 1 line 15 of the Specification). It is disclosed as a design pertaining to prior art systems. Nowhere does the Appellant state that this is the definition for the inventive system. The specification is silent as to the inventive dental treatment system (i.e. dental bracket table, portable base unit and suspension device) being compacted and bundled so that a relatively fit person can physically carry the inventive dental system. The disclosure does not describe the dental bracket table and suspension device being designed such that they can be compacted and bundled. This is also

Art Unit: 3732

indicated in the title “Easy Access Dental Field Operating and Treatment System having Over-the-Patient Delivery” (Specification, page 1, line 1) and in the abstract: “[a] dental treatment system, which can include at least one dental bracket table; at least one portable base unit and at least one suspension device (Abstract, p.15, line 4). Furthermore, it is noted that the Appellant has written “permanent (e.g., non-portable) dental operatories” (page 3 line 24 of the Specification), implying that “permanent” could be “non-portable”; therefore, portable could mean “mobile” as disclosed by Seidman. (Permanent dental operator is used in the art to mean stationary or fixed dental operator, such as one found in a dental practitioner’s office.) It is believed that the Appellant’s disclosure does not meet the test of the inventor acting as his own lexicographer and clearly setting forth a different definition. The Examiner does not find the definition of “portable” that the Appellant contends is the definition for the inventive dental system.

Secondly, the Appellant argues that the Examiner used improper hindsight to combine the isolated teachings of the secondary reference on pages 10-13 of the brief. Appellant's argument on page 10 of the brief:

"Applicant respectfully submits that independent claims 1 (and claims 2-10 depending therefrom) and 18 (and claims 19-21 depending therefrom) are patentable over the art of record. Specifically, Applicant respectfully submits that the Examiner is using impermissible hindsight in rejecting the claims. It is impermissible to use the claimed invention as an instruction manual or template; to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . . 'One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992)(quoting In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988)). In this regard, the Examiner is using the Applicant's specification to combine the features of portable dental systems and over-the-patient office dental systems to reach the claimed combination. However, this combination is precisely what Applicant's invention is - a portable dental system which includes the advantageous features of an over-the-patient dental system. Before Applicant's invention, the prior art failed to teach or suggest such a combination."

It is of the Examiner's opinion that only knowledge found in the prior art of portable dental treatment systems has been employed in the formulation of the conclusion of obviousness in combining references to Seidman and Bailey et al. Note, the expressed disclosure of over-the-patient "portable" dental treatment system of Seidman and the expressed teaching of what is contained in a portable dental base unit such as a suction pump and waste container of Bailey et al. In assembling the references for consideration, a certain amount of hindsight is always required in that it is necessary for the Examiner to analyze the claimed invention, discover the relevant prior art, determine the differences between the nearest prior art and the claimed invention, and decide whether these differences are taught in the prior art, *Graham v John Deere Co.*, 148 USPQ 459 (US SupCt 1966). Such hindsight is not objectionable, so long as the examiner takes into account only knowledge which was within the level of ordinary skill at the

Art Unit: 3732

time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is submitted that the references to Seidman and Bailey et al. taken together are clearly suggestive of the claimed invention.

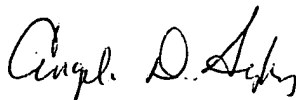
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

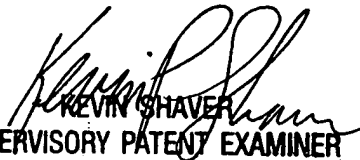


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